

REMARKS

The present Response is intended to be fully responsive to the rejections raised in the Office Action, and is believed to place the application in condition for allowance. Furthermore, the Applicants do not acquiesce to any portion of the Office Action not particularly addressed.

In the Office Action, the Examiner noted claims 1-34, 36-38, 40-43 and 45 are pending and rejected. More specifically, the Office rejected claim 13 under 35 U.S.C. § 112; claims 1-10, 12-19, 21-31, 33-41, and 44-45 under 35 U.S.C. § 102(e); and claims 11, 20, 32, 42, and 43 under 35 U.S.C. 103(a).

In view of the following discussion, the Applicants submit all of the claims pending in the application fully comply with the provisions of 35 U.S.C. §§ 102, 103, and 112. Thus, the Applicants assert all of these claims are now in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

A. Claim Rejection under 35 U.S.C. § 112 – Claim 13

The Office rejected dependent claim 13 under 35 U.S.C. § 112, ¶ 2, as being indefinite. More specifically, the Office rejected claim 13 because the Office "cannot determine how an email with an attachment is sent from the sender to the recipient when 'the attaching is performed by the recipient's device'." The Applicants traverse this rejection.

The Applicants submit the reason why the Office cannot determine how the "the attaching" can occur at the recipient's device is because the Office improperly presupposed limitations not found in independent claim 8, and in turn, in its dependent claim 13. That is, the Office presumed independent claim 8 requires attaching the sound file and/or the predetermined identifier to the electronic message *before* it is sent from the sender's device¹. Independent claim 8, however, does not recite elements

¹ The Office's own statement "an email with an attachment is sent from the sender" (emphasis added) evinces the Office presupposed independent claim 8, and in turn, claim 13, to require "the attaching" to occur *before* the electronic message is sent from the sender's device.

limiting it as such, and moreover, independent claim 8 does not recite elements requiring "the attaching" to occur *before* the electronic message is received by the recipient's device. In fact, claims 11 and 12, which depend from independent claim 8 as well, clearly indicate that the sound file and/or the predetermined identifier can be attached *after* the electronic message is sent from the sender's device.

How "the attaching" of the sound file and/or the predetermined identifier can occur at the recipient's device is quite simple; if, of course, not obfuscated by the improper presupposed limitations. Several explanations on how this is possible are detailed throughout the Applicants' specification. In one particular disclosed example, the sound file and/or the predetermined identifier may be sent separately from the electronic message, and then attached to the electronic message at the recipient's device. See Applicants' Specification, at p. 4-5.

In light of the forgoing, the Applicants submit dependent claim 13 is not indefinite and not missing any essential steps or elements. Rather, dependent claim 13 fully complies with 35 U.S.C. § 112. Thus, the Applicants request the Office to withdraw the rejection.

B. Rejection under 35 U.S.C. § 102(e) - Claims 1-10, 12-19, 21-31, 33-41 and 45

In the present Final Office Action, the Office, once again, rejected claims 1-10, 12-19, 21-31, 33-41 and 44-45 under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,801,931 to Ramesh, et al. (hereinafter "*Ramesh*"). In making the rejection, the Office remarked "Ramesh clearly and explicitly teach[es] the invention as claimed [...] Ramesh teaches a speaker identifier that distinguishes the sound file and [that] indicates a course of action to be taken" (emphasis added). See Office Action, at page 10, point no. 7. The Office also remarked "[n]ew citations have been presented in the rejections set forth above" (emphasis added). *Id.*

The Office's remarks along with the Office's citations to and quotations from *Ramesh* juxtaposed against the elements of claims 1, 8 and 24 in the referenced rejection indicates the Office contended *Ramesh's* "one or more attached documents or files" and

"speaker identifier" read on the claimed *attached sound file* and *attached predetermined identifier*, respectively. Notably, explicitly missing from the referenced rejection is any mention of *Ramesh's* "basis vectors" reading on either the claimed *attached sound file* or the claimed *attached predetermined identifier*.

Failure to Provide Prima Facie Case of Unpatentability under 35 U.S.C. § 102

The standard of anticipation under 35 U.S.C. § 102 is "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference", and "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Although purportedly based on this standard, the combination of the Office's remarks along with the citations to, and quotations from, *Ramesh*, *on their face*, clearly indicates otherwise. To this end, the Office's rejection of independent claim 1, in pertinent part, is reproduced below in table form².

| Independent Claim 1 | Office's Quotations/Remarks | <i>Ramesh</i> Citation |
|---|---|---------------------------|
| an attached sound file; and | "and one or more attached documents or files of various types (e.g., word processor files, image files, audio files, spreadsheets, executable programs, or others)" | col. 2, ll. 14-19, |
| an attached predetermined identifier associated with the sound file, the predetermined identifier comprising: | "[t]o <u>differentiate the intended speaker from the sender of the message</u> , a <u>speaker identifier</u> is added to the electronic message" | col. 3, ll. 49-61 |
| (i) a distinguishing indication configured to <u>distinguish the sound file from other files attached to the electronic message</u> ; and | "The <u>speaker identifier</u> is an electronic label that <u>corresponds to a specific set of basis vectors</u> . In one implementation, it may correspond to the name of the speaker and comprise ASCII text added to the message header" | col. 3, ll. 53-57 |
| (ii) a course of action indication configured to indicate a course of action to be taken by the recipient's device | "The <u>speaker identifier</u> <i>tells</i> the recipient's communication device 120 <u>which set of stored basis vectors to associate with the received</u> | col. 3, ll. 57-61 |

² The claim language and Office's quotations/remarks in the table include Applicant-added emphasis.

| | | |
|---|---|---|
| with the sound file, the course of action indication comprising an information tag; | <u>message payload when a set of basis vectors is NOT attached thereto</u> | |
| wherein based on the course of action indicated by the predetermined identifier, the recipient's device is configured to selectively convert a content of the electronic message from text to voice using at least one of the sound file and a locally stored voice sample; and | "the recipient's communication device renders the text to the recipient as audible speech"; and "the recipient's communication device uses the included <u>speaker identifier to associate a specific set of STORED basis vectors with the message payload</u> " | co1. 2, ll. 35-37 co1. 3, l. 61 - co1 .4, l. 2 |

As can be readily discerned from the table above, independent claim 1 recites *an attached sound file*, and *an attached predetermined identifier* that (i) *is associated with the sound file*, and (ii) *comprises a distinguishing indication configured to distinguish the attached sound file from other files attached to the electronic message*. The Office's rejection, however, makes no mention of *Ramesh's* speaker identifier being used to distinguish one of *Ramesh's* "one or more attached documents or files" from another, or for that matter, being associated with such "one or more attached documents or files", whatsoever.

Rather, the Office's rejection states the speaker identifier is added to the electronic message "[t]o *differentiate the intended speaker from the sender of the message*. Moreover, the Office's rejection states the speaker identifier (i) *corresponds to a specific set of basis vectors*, and (ii) *tells* the recipient's communication device to associate a specific set of STORED basis vectors therein with a received message payload when a set of basis vectors is NOT attached thereto. Clearly, the Office's remarks, quotations and citations, *on their face*, failed to show *Ramesh* discloses each and every element of independent claim 1, and much less show *Ramesh* discloses the identical invention in as complete detail as contained in the independent claim 1.

Each of the independent claims 8 and 24 recite language similar to independent claim 1 with respect to the *attached sound file* and *attached predetermined identifier*. Accordingly, the Office's remarks, quotations and citations, *on their face*, failed to show that *Ramesh* discloses each and every element of and/or the identical invention in as complete detail as contained in each of the independent claims 8 and 24.

In view of the foregoing, the Office has failed to properly apply the standard of anticipation under 35 U.S.C. § 102 when setting forth its rejection. Thus, the Office has failed to present a *prima facie* case of unpatentability under 35 U.S.C. § 102.

Ramesh Fails to Anticipate Claims 1-10, 12-19, 21-31, 33-41 and 44-45

Notwithstanding the lack of a *prima facie* case of unpatentability under 35 U.S.C. § 102, the Applicants submit that *Ramesh* fails to anticipate each of the claims 1-10, 12-19, 21-31, 33-41 and 44-45 for the reasons set forth in the Applicants' prior Responses and in the section of this Response directly above, as well as, for the reasons set forth below. For simplicity sake and avoidance of repetition, the Applicants' prior Responses and the section of this Response directly above will not be repeated but rather are incorporated by reference herein.

As noted above, the Applicants' independent claim 1 is directed to an electronic message configured to be communicated between a sender's device and a recipient's device. The claimed electronic message includes **both** *an attached sound file and an attached predetermined identifier associated with the attached sound file*. Additionally, the *attached predetermined identifier* includes *a distinguishing indication configured to distinguish the attached sound file from other files attached to the electronic message*. The *predetermined identifier* is configured in this way for a multitude of reasons, including (i) to alert the recipient's device that the electronic message includes the *attached sound file*, and (ii) to enable the recipient's device to determine which one of a plurality of files **attached to** the electronic message (if, of course, more than one is attached) is the *attached sound file*. At a minimum, the claimed *distinguishing indication*, and in turn, the *attached predetermined identifier* are not found in the Office-cited and corresponding portions of *Ramesh*.

Ramesh is directed to "a system and method for personalizing electronic messages by rendering them to recipients in the voice of a predetermined human speaker." *Ramesh*, at col. 1, ll. 28-34. According to *Ramesh*, "this is accomplished by **associating** [] a message payload [with] a set of basis vectors comprising speech parameters from the

predetermined human speaker for use in speech synthesis" (emphasis added). *Id.*, at Abstract. *Ramesh* discloses several different embodiments detailing how to carry out such association. Of particular interest here, given the Office's citations, are *Ramesh*'s embodiments described with reference FIGs. 2, 4 and 5 (hereinafter "FIG. 2 embodiment", "FIG. 4 embodiment" and "FIG. 5 embodiment", respectively).

According to *Ramesh*'s FIG. 2 embodiment, "a message payload is created" in which "[t]he message payload may comprise simply text, or it may comprise a combination of a text message and one or more attached documents or files of various types (e.g., word processor files, image files, audio files, spreadsheets, executable programs, or others), some of which may also be, at least in part, text" (emphasis added). *Id.*, at col. 2, ll. 11-19. "The set of basis vectors associated with a predetermined human speaker *is additionally attached to the message payload*, whether there are other attachments already present or not" (emphasis added). *Id.*, at col. 2, ll. 21-24. The set of basis vectors are speech parameters associated with a particular speaker (emphasis added). *See Id.*, col. 2, ll. 42-62. These speech parameters model the particular speaker's voice and can be used subsequently to perform text-to-speech conversion. *See Id.* "The combined message payload and attached set of basis vectors, which may comprise the electronic message, are then transmitted through a communications network" (emphasis added). *Id.*, at col. 2, ll. 25-27. "The electronic message is received at the remote end[, and t]he recipient's communication device [] processes the electronic message to separate the basis vectors from the message payload and, optionally, to synthesize as computer generated speech the text contained in the message payload, including the primary text message and any text attachments or text portions thereof, *based on a voice model defined by the received set of basis vectors.*" *Id.*, at col. 2, ll. 28-35. "[T]he recipient's communication device renders the text to the recipient as audible speech." *Id.*, at col. 2, ll. 35-37.

Unlike *Ramesh*'s FIG. 2, *Ramesh*'s FIG. 4 embodiment discloses: "FIG. 4 illustrates the operation of another process 400 **to avoid unnecessarily sending the set of basis vectors**" (emphasis added). *Id.*, at col. 2, ll. 63-64. In this embodiment, *Ramesh* states:

"As shown in FIG. 4, the set of basis vectors is attached to the message payload by the sender's communication device **ONLY IF it has not been sent previously [] to a given recipient ...** If the specified set of basis vectors has already been sent, ONLY the message payload is transmitted to the recipient ... Upon receiving the electronic message, the recipient's communication device determines [] whether or not a set of basis vectors is attached ... If [] a set of basis vectors is NOT attached, the recipient's communication device [] examines an identifier within the message payload []. The identifier may comprise the electronic return address of the message payload (e.g., john.doe@internet.net), a domain name (e.g., "mynetwork.net"), an alias or nickname, an e-mail account user name (e.g., "john.doe85"), an IP address, or the name of a person from the "name" field in the message header (e.g., "John Doe"). ... *[A]n attempt is made to match the identifier with a set of basis vectors STORED at the recipient's communication device.* ... The recipient's communication device may select the appropriate set of basis vectors matching the identifier of the message payload from among a plurality of such sets of basis vectors, **depending on from how many users the recipient has received such sets of basis vectors**" (emphasis added). *Id.*, at col. 2, l. 65 – col. 3, l. 40.

The quotation above clearly illustrates that *Ramesh's* FIG. 4 embodiment is in conflict with *Ramesh's* FIG. 2 embodiment in that the latter teaches sending to the recipient's communication device an electronic message having a set of basis vectors attached thereto, whereas the former teaches a process specifically *used to avoid unnecessarily sending the set of basis vectors attached to* the electronic message. To carry out this process, an "identifier" contained within the message payload is *used* by the recipient's communication device to select the appropriate set of basis vectors from a plurality of sets of basis vectors STORED therein.

Notably, *Ramesh's* FIG. 4 embodiment discloses the recipient's communication device determining whether or not a set of basis vectors are attached, and if a set of basis vectors is *not* attached, then examining and otherwise using the "identifier" in the message payload. *Ramesh's* FIG. 4 embodiment does not disclose examining and otherwise using the "identifier" if the recipient's communication device determines that the set of basis vectors is attached. Common sense and logic, however, indicate that the "identifier" is of no use in *Ramesh's* FIG. 4 embodiment if the set of basis of vectors are attached. The "identifier" is of no use because *Ramesh's* recipient's communication

device can use the attached set of basis vectors in accordance with *Ramesh's* FIG. 2 embodiment without incurring additional costs involved with carrying out *Ramesh's* FIG. 4 embodiment.

Like *Ramesh's* FIG. 4 embodiment, *Ramesh's* FIG. 5 embodiment is in conflict with *Ramesh's* FIG. 2 embodiment in that it too teaches a process *used to avoid unnecessarily sending the set of basis vectors*, and an "identifier" contained within the message payload that is *used* by the recipient's communication device to select the appropriate set of basis vectors from a plurality of sets of basis vectors STORED therein. *Ramesh's* FIG. 5 embodiment, however, differs from *Ramesh's* FIG. 4 embodiment in that its "identifier", namely, the "speaker identifier", is explicitly added to the electronic message to solve a problem left unresolved by *Ramesh's* FIG. 4 embodiment. More particularly, *Ramesh* states, in pertinent part:

"... In some cases, *different individuals send e-mail messages from the same e-mail account, meaning the same return address and sender's name are associated with each sent message, regardless of who the actual sender was at the time*. This is true if an entire family, for example, shares a single e-mail address. To differentiate the intended speaker from the sender of the message, a speaker identifier is added to the electronic message at 510. In one implementation, the speaker identifier may be added to the message header. The speaker identifier is an electronic label that corresponds to a specific set of basis vectors. In one implementation, it may correspond to the name of the speaker and comprise ASCII text added to the message header as a separate field. The speaker identifier tells the recipient's communication device [] which set of STORED basis vectors to associate with the received message payload when a set of basis vectors is not attached thereto, allowing multiple senders to share the same return address. At 520, the sender's communication device determines whether a set of basis vectors corresponding to the speaker identifier has been sent previously. If not, the **appropriate** set of basis vectors is attached at 530. If so, the message payload proceeds to the remote end (240) **without** an attached set of basis vectors. At 540, the recipient's communication device uses the included speaker identifier to associate a specific set of STORED basis vectors with the message payload.

Process 500 thus enables, for example, a brother and sister to have sets of basis vectors corresponding to their respective voices stored on their grandmother's communication device from previous messages, to send new text messages to their grandmother without attaching the sets of basis vectors, and to share the same return e-mail address. When the grandmother receives a message from the granddaughter, for example, the grandmother's communication device automatically uses the granddaughter's speaker identifier included in the message payload to associate the granddaughter's PRE-STORED set of basis vectors with the message and to render the text portions as synthesized speech." (emphasis added). *Id.*, at col. 3, l. 44 – col. 4, l. 15.

The foregoing quotation clearly illustrates that the "speaker identifier" of *Ramesh's* FIG. 5 embodiment, like the "identifier" in *Ramesh's* FIG. 4 embodiment, is used by the recipient's communication device to select the appropriate set of basis vectors from a plurality of sets of basis vectors STORED therein, when a set of basis vectors is not attached to the electronic message. In addition, the "speaker identifier" overcomes the limitation of the "identifier" of *Ramesh's* FIG. 4 embodiment by providing a way to differentiate the intended speaker from the sender of the message.

Conspicuously absent from *Ramesh's* FIG. 5 embodiment is any disclosure of the recipient's communication device using the "speaker identifier" in any manner if a set of basis vectors is attached to the electronic message. As above, common sense and logic indicate that the "speaker identifier" is of no use in *Ramesh's* FIG. 5 embodiment if the set of basis of vectors are attached because the recipient's communication device can use the attached set of basis vectors in accordance with *Ramesh's* FIG. 2 embodiment without incurring additional costs involved with carrying out *Ramesh's* FIG. 5 embodiment.

In sum, *Ramesh's* FIG. 2 embodiment discloses a process in which an electronic message comprised of a message payload along with a set of basis vectors, and possibly, "one or more documents or files" attached thereto is sent to a recipient's communication device. *Ramesh's* FIG. 2 embodiment, however, does not disclose any identifier associated with the attached set of basis vectors and/or the "one or more documents or files." *Ramesh's* FIG. 4 and 5 embodiments disclose processes specifically

used to avoid unnecessarily sending the set of basis vectors attached to the electronic message. To facilitate this, *Ramesh's* FIG. 4 and 5 embodiments disclose using "identifiers" contained within the message payload. These identifiers are not associated with a set of basis vectors *attached to the electronic message* and/or the "one or more documents or files" *attached to the electronic message*. Rather, the "identifiers" are associated with a set of basis vectors previously STORED on the recipient's communication device, and *used to select* the appropriate set of basis vectors from a plurality of sets of basis vectors STORED on the recipient's communication device, when a set of basis vectors is not attached to the electronic message. However, none of *Ramesh's* FIG. 2, 4 and 5 embodiments discloses any identifier that is (i) attached to an electronic message, (ii) associated with the "one or more documents or files" attached to the electronic message, and (ii) configured to distinguish one of these "one or more documents or files" from another. Clearly, then, none of *Ramesh's* FIG. 2, 4 and 5 embodiments discloses the claimed *predetermined identifier*, which (i) *is attached to the claimed electronic message*, (ii) *is associated with the sound file attached to the electronic message*, and (iii) *includes a distinguishing indication configured to distinguish the attached sound file from other files attached to the electronic message.*

In view of the foregoing, *Ramesh* fails to disclose at least the claimed *predetermined identifier* and all of its features. As such, *Ramesh* fails to anticipate independent claim 1 under 35 U.S.C. § 102.

Each of the independent claims 8 and 24 recite language similar to independent claim 1 with respect to the *predetermined identifier*. Accordingly, *Ramesh* fails to anticipate each of the independent claims 8 and 24 under 35 U.S.C. § 102 for at least the reasons expressed with respect to independent claim 1.

Claims 2-8, 8-10, 12-19, 21-23, 25-31, 33-41 and 44-45 are dependent, either directly or indirectly, upon independent claims 1, 8, and 24 and thus, necessarily include all of the elements of independent claims 1, 8, and 24. Accordingly, for at least the same reasons discussed above, *Ramesh* fails to anticipate each of the dependent claims 2-8, 8-10, 12-19, 21-23, 25-31, 33-41 and 44-45 under 35 U.S.C. § 102, as well.

Based on the foregoing, the Applicants request the Office to withdraw the 35 U.S.C. § 102 rejection of claims 1-10, 12-19, 21-31, 33-41 and 44-45.

C. Rejection under 35 U.S.C. § 103(a) – Claims 11, 20, 32, 42 and 43

The Office rejected claims 11, 20, 32, 42 and 43 under 35 U.S.C. § 103(a) as being unpatentable over *Ramesh* in view of United States Patent No. 6,085,231 to Agraharam, et al. ("*Agraharam*"). The Applicants traverse this rejection, as well.

In making the § 103 rejection, the Office contended that the combination of *Ramesh* and *Agraharam* discloses, teaches or suggests all of the elements of each of the dependent claims 11, 20, 32, 42 and 43. More particularly, the Office contended the combination of *Ramesh* and *Agraharam* discloses the elements recited in each of the dependent claims 11, 20, 32, 42 and 43 as well as all of the elements of its respective independent claim 1, 8 or 24, due to its dependency from such independent claim. In support of these contentions, the Office relied on *Ramesh* for the proposition that it discloses, teaches or suggests all of the elements of each of the independent claims 1, 8 and 24, and relied on *Agraharam* for the proposition that it discloses, teaches or suggests the elements recited in each of the dependent claims 11, 20, 32, 42 and 43. Notably, the Office did not rely on *Agraharam* for the proposition that it discloses, teaches or suggest the elements of any of the independent claims 1, 8 and 24.

The Applicants submit that, as discussed above with respect to each of the independent claims 1, 8 and 24, *Ramesh* fails disclose, teach, or suggest at least the claimed *predetermined identifier* and all of its features. As such, *Ramesh* fails disclose, teach, or suggest all of the claimed combination of elements of each of the independent claims 1, 8 and 24.

In view of the foregoing, the Applicants submit that *Ramesh* and *Agraharam*, alone or combined, fail disclose, teach, or suggest all of the claimed combination of elements of each of the dependent claims 11, 20, 32, 42 and 43. The Applicants therefore submit each of the dependent claims 11, 20, 32, 42 and 43 is non-obvious under

35 U.S.C. § 103(a) over *Ramesh* in view of *Agraharam*, and in turn, request the Office to withdraw the 35 U.S.C. 103(a) rejection of each of the claims 11, 20, 32, 42 and 43.

CONCLUSION

In view of the foregoing, the Applicants submit all of the claims now pending in the application are definite under the provisions of 35 U.S.C. § 112, novel under the provisions of 35 U.S.C. § 102(e), and are non-obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicants believe all claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes any unresolved issues still exist or if, in the opinion of the Examiner, a telephone conference would expedite passing the present application to issue, the Examiner is invited to call John P. Maldjian, Esq. at 732-275-3100 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Date: September 20, 2010

By: /s/John P. Maldjian /
John P. Maldjian, Esq.
Registration No. 41,967